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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,185	08/02/2001	Dan E. Robertson	DIVER1100-5	7592
25548	7590	11/28/2003		
MARK M. TAKAHASHI GRAY CARY WARE & FREIDENRICH, LLP 4365 EXECUTIVE DRIVE, SUITE 1100 SAN DIEGO, CA 92121-2133			EXAMINER STEADMAN, DAVID J	
			ART UNIT	PAPER NUMBER
			1652	8

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/922,185

Applicant(s)

ROBERTSON ET AL.

Examiner

David J Steadman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Status of the Application***

**[1]** Claims 1-10 are pending in the application.

**[2]** Receipt of Information Disclosure Statements filed September 23, 2002 and June 30, 2003 is acknowledged.

**[3]** Claim 1 is drawn to a polynucleotide encoding the polypeptide of SEQ ID NO:7 or 9. However, the sequence listing indicates the presence of only 8 sequence identifiers and the only amino acid sequences disclosed in the sequence listing are SEQ ID NO:6 and SEQ ID NO:8. In the interest of advancing prosecution, the claims have been examined as though they recite SEQ ID NO:6 and SEQ ID NO:8 instead of SEQ ID NO:7 and SEQ ID NO:9, respectively.

**[4]** The specification refers to sequence identifiers that are not present in the instant application – particularly SEQ ID NO:9 and SEQ ID NO:28-36. For example, page 10, paragraphs [0052]-[0054] of the instant specification.

**[5]** The claims are not numbered consecutively as required by 37 CFR § 1.126. Claim 12 has been renumbered as claim 10.

**[6]** Claim 7 improperly depends from non-existent claim 14. In the interest of advancing prosecution, claim 7 has been interpreted as depending from claim 6.

**[7]** Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

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If applicant desires priority under 35 U.S.C. 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application.

### ***Sequence Compliance***

**[8]** This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825; applicants' attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). To be in compliance, applicants should identify sequences disclosed in the specification with proper sequence identifiers. See particularly page 19 of the instant specification.

### ***Election/Restrictions***

**[9]** Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim(s) 1-4 and 6-9, drawn to an isolated polynucleotide encoding SEQ ID NO:6, a vector, a host cell, a process for producing a polypeptide using

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said host cell, and a process for producing a transformed cell, classified in class 435, subclass 192.

- II. Claim(s) 1-3 and 5-9, drawn to an isolated polynucleotide encoding SEQ ID NO:8, a vector, a host cell, a process for producing a polypeptide using said host cell, and a process for producing a transformed cell, classified in class 435, subclass 192.
- III. Claim(s) 10, drawn to a method for catalyzing an oxidation reaction by administering an effective amount of SEQ ID NO:6, classified in class 435, subclass 155.
- IV. Claim(s) 10, drawn to a method for catalyzing an oxidation reaction by administering an effective amount of SEQ ID NO:8, classified in class 435, subclass 155.

**[10]** The inventions are distinct, each from the other because:

**[11]** The polynucleotides of Inventions I-II are structurally distinct and neither of the polynucleotides would render the other obvious to one of ordinary skill in the art.

**[12]** The polynucleotides of Inventions I-II are unrelated to the method(s) of Inventions III-IV as they are neither used nor made by the method(s) of Inventions III-IV.

**[13]** The methods of Inventions III-IV are independent as they utilize different products.

**[14]** MPEP § 803 sets forth two criteria for a proper restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed and (B) There must be a serious burden on the examiner. As shown above, Inventions I-IV

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are independent or distinct, thus satisfying the first criterion for a proper restriction. MPEP § 803 additionally states that a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search. Each of the inventions requires a separate patent and non-patent literature search requiring a different text and sequence search for each Invention and thus, co-examination of Inventions I-IV would place a serious burden on the examiner.

### ***Conclusion***

**[15]** Claims 1-3 and 6-10 will be examined only to the extent the claims read on the elected subject matter.

**[16]** Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

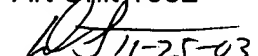
**[17]** Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:00 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for submission of official papers to Group 1600 is (703) 308-4242. Draft or

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informal FAX communications should be directed to (703) 746-5078. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman  
Patent Examiner  
Art Unit 1652

  
11-25-03  
**DAVID STEADMAN**  
**PATENT EXAMINER**